



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,624	08/28/2003	Hiroki Yamauchi	2003_1212A	5300
513 7590 08/20/2008 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021				
EXAMINER				
OKORONKWO, CHINWENDU C				
ART UNIT		PAPER NUMBER		
2136				
MAIL DATE		DELIVERY MODE		
08/20/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/649,624

Applicant(s)

YAMAUCHI ET AL.

Examiner

CHINWENDU C. OKORONKWO

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on has been entered.

Response to Remarks/Arguments

2. Applicant's arguments with respect to the rejection of the claims have been fully considered but they are not persuasive.

2.1 In response to Applicant argument that nothing in Alve discloses or suggests the use of an in-group remaining number and the out-group remaining number and that Alve does not disclose or suggest structure for managing the number of content duplications, with use of the in-group remaining number and the out-group remaining number, the Examiner respectfully disagrees citing paragraphs 43-52 which recites, copy control, domain traversal; paragraphs 56-59 which recites verifying device belongs to domain; and paragraphs 60-65 which recites, copy control, domain traversal, and a positive integer.

Double Patenting

3. Despite the amendments made by the Applicant to overcome the double patenting rejection of the previous office action, the Examiner maintains the rejection as the Examiner understands Claims 45-60 to be provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of US Patent No. **7,188,224**.

Claim 1 of 10/649,624:

a content management apparatus that manages content duplications performed on an apparatus connected to a network, the content management apparatus comprising:

a holding unit operable to hold duplication restriction information indicating (i) a content identifier for identifying a content, (ii) an in-group remaining number indicating a value of a number of permitted content duplications, and (iii) an out-group remaining number indicating a value of a number of permitted duplications, the in-group remaining number and the out-group remaining number corresponding to the content identifier;

a request receiving unit operable to receive, from the apparatus, a management request including the content identifier;

a group judging unit operable to judge whether the apparatus that has made the management request belongs to a predetermined group; and

a management unit operable to (i) manage duplication of the content identified by the content identifier included in the management request, with use of the in-group remaining number corresponding to the content identifier, if the apparatus that has made the management request is judged to belong to the group, and (ii)

Claim 1 of 7,188,224:

a content management apparatus operable to manage a number of content duplications performed on a plurality of apparatuses connected to a network, comprising:

a holding unit operable to respectively hold an in-group remaining number and an out-group remaining number, the in-group remaining number indicating a number of permitted content duplications performed on an apparatus belonging to a predetermined group, and the out-group remaining number indicating a number of permitted duplications performed on an apparatus not belonging to the predetermined group;

a group judging unit operable to judge whether at least one apparatus of the plurality of apparatuses belongs to the predetermined group; and

a management unit operable to manage the number of content duplications performed on the at least one apparatus based on the in-group remaining number when the at least one apparatus is judged to belong to the predetermined group by said group judging unit, and manage the number of content duplications performed on the at least

Art Unit: 2136

<p>manage duplication of the content identified by the content identifier included in the management request, with use of the out-group remaining number corresponding to the content identifier, if the apparatus that has made the management request is judged to not belong to the group.</p>	<p>one apparatus based on the out-group remaining number when the at least one apparatus is judged not to belong to the predetermined group by said group judging unit (claim 29, instant application) is analogous to a networked apparatus that belongs to a group, and that is connected via a network to at least one device in the group and to at least one device out of the group,</p> <p>said networked apparatus comprising: a storage unit operable to store a content and duplication restricting information that is attached to the content, the duplication restricting information indicating a permitted number, of duplications, which represents a number of times that the content is able to be duplicated to a device, wherein the permitted number of duplications is a sum of a permitted number of duplications to a first type of device and a permitted number of duplications to a second type of device; a receiving unit operable to receive, from a device, a duplication request for the content; a judging unit operable to judge whether the device is in the group, or out of the group; and a control unit operable to duplicate the content to the device if said judging unit judges that the device is in the group, and impose restrictions on duplication of the content to the device if said judging unit judges that the device is out of the group (claim 1, patent);</p>
---	--

3. Claims 24-36 of allowed Application No. **10/681017** contains every element of claims 1-23 of the instant application and thus anticipate the claims of the instant application. Claims 1-23 of the instant application therefore are not patently distinct

from the allowed application claims and as such are unpatentable for obvious-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

4. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species with that genus). "ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

5. "Claim 12 and Claim 13 are generic to the species of invention covered by claim 3 of the patent. Thus, the generic invention is "anticipated" by the species of the patented invention. Cf., Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim) 4. This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic claim. In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); Schneller, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the

Art Unit: 2136

doctrine of obviousness-type double patenting.” (In re Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993)).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 45-60 are rejected under 35 U.S.C. 102(e) as being disclosed by Alve (U.S. Patent Application No. 2003/0076955, herein Alve).

Regarding claim 45 and 57-59, Alve, discloses a content management method and apparatus operable to manage a number of content duplications performed on a plurality of apparatuses connected to a network, comprising **(abstract)**:

a holding unit operable to respectively hold duplication restriction information indicating (i) a content identifier for identifying a content, (ii) an in-group remaining number indicating a value of a number of permitted duplications, and (iii) an out-group remaining number indicating a value of a number of permitted duplications, the in-group remaining number indicating a number corresponding

to the content identifier and a request receiving unit operable to receive, from the apparatus, a management request including the content identifier (**pars. 43-52, copy control, domain traversal**);

a group judging unit operable to judge whether at least one apparatus of the plurality of apparatuses belongs to the predetermined group (pars. 43-52, **domain traversal**); and

a management unit operable to manage the number of content duplications performed On the at least one apparatus based on the in-group remaining number when the at least one apparatus is judged to belong to the predetermined group by said group judging unit, and manage the number of content duplications performed on the at least one apparatus based on the out-group remaining number when the at least one apparatus is judged not to belong to the predetermined group by said group judging unit
(pars. 60-65, copy control, domain traversal, positive integer).

Regarding claim 46, Alve, discloses a management unit, when the request has been made is a duplication request for duplicating the content and if the apparatus for duplicating the content that has made the management request is judged to belong to the group, (i) duplicates the content identified by the content

identifier, the apparatus that has made the management request, and subtracts a predetermined value from the in-group remaining number corresponding to the content identifier included in the management request, if the in-group remaining number is not "0," and (ii) rejects the management request if the in-group remaining number is "0," and if the apparatus that has made the management request is judged not to belong to the group, (i) duplicates the content identified by the content identifier, for the apparatus that has made the management request, and subtracts a predetermined value from the out-group remaining number corresponding to the content identifier included in the management request, if the out-group remaining number is not "0," and (ii) rejects the management request if the out-group remaining number is "0" (pars. 43-52, copy control, **domain traversal**, 56-59, verifying device belongs to domain, 60-65, copy control, **domain traversal**, positive **integer**).

Regarding claim 47, Alve, discloses content management apparatus, wherein said management unit, when the management request that has been made is a deletion request for deleting the content, (i) adds the predetermined value to the in-group remaining number, if the apparatus that has made the management request is judged to belong to the group, and (ii) adds the predetermined value to the out-group remaining number, if the apparatus that has made the management request is judged to not belong to the group (**pars. 43-52, copy**

control, domain traversal, 56-59, verifying device belongs to domain, 60-65, copy control, domain traversal, positive integer).

Regarding claim 48, Alve, discloses a content management apparatus further comprising: an acquisition unit operable to acquire a start time of a processing pertaining to the management request of the content; and a time management unit operable to output an operation instruction to said management unit at the start time, wherein said management unit, upon receipt of the operation instruction, (i) manages the number of content duplications performed on the apparatus based on the in-group remaining number, if the apparatus is judged to belong to the group by said group judging unit, and (ii) manages the number of content duplications performed on the apparatus based on the out-group remaining number, if the apparatus is judged to not belong to the group by said group judging unit (**pars. 43-52, copy control, pars. 60-63, further copy control time related**).

Regarding claim 49, Alve, discloses a content management apparatus further comprising: an acquisition unit operable to acquire a usage expiration date of the content; and a time management unit operable to output an operation instruction to said management unit when the usage expiration date has passed, wherein said management unit, upon receipt of the operation instruction, (i) manages the

number of content duplications performed on the apparatus based on the in-group remaining number, if the apparatus is judged to belong to the group by said group judging unit, and (ii) manages the number of content duplications performed on the apparatus based on the out-group remaining number, if the apparatus is judged to not belong to the group by said group judging unit (**pars. 43-52, copy control, pars. 63-66, voucher based access permissions to content**).

Regarding claim 50, Alve, discloses a content management apparatus of claim 45, wherein said management unit further notifies, to the apparatus, transfer information indicating (i) a number that is less than or equal to the in-group remaining number and (ii) a number that is less than or equal to the out-group remaining number, and subtracts the numbers indicated by the transfer information from the in-group remaining number and the out-group remaining number (**pars. 43-52, copy control, pars. 63-66, voucher based access permissions to content**).

Regarding claim 51, Alve, discloses a content management apparatus of claim 45, further comprises:
an acquisition unit operable to acquire duplication-generation information relating to the content, wherein said management unit (i) manages the duplication of the

content identified by the content identifier included in the management request, based on the duplication-generation information and the in-group remaining number, if the apparatus that has made the management request is judged to belong to the group, and (ii) manages the duplication of the content identified by the content identifier included in the management request, based on the duplication-generation information and the out-group remaining number, if the apparatus that has made the management request is judged to not belong to the group (**pars. 43-52, copy control, pars. 63-66, voucher based access permissions to content, pars. 71-74, transferring copies, access**).

Regarding claim 52, Alve, discloses a content management further comprising: an acquisition unit operable to acquire request-apparatus information unique to the apparatus and a revocation list indicating one or more apparatuses to which content duplication is not permitted, wherein said management unit (i) manages the duplication of the content identified by the content identifier included in the management request, based on the request-apparatus information, the revocation list, duplication-generation information and the in-group remaining number, if the apparatus that has made the management request is judged to belong to the group, and (ii) manages the duplication of the content identified by the content identifier included in the management request, based on the request-apparatus information, the revocation list, the duplication-generation information and the out-group remaining number, if the apparatus that has made the

management request is judged to not belong to the group (**pars. 21-25, domain, household devices, LAN**).

Regarding claim 53, Alve, discloses a content management further comprising: an acquisition unit operable to acquire request-area information indicating an area relating to the apparatus, wherein said management unit (i) manages the duplication of the content identified by the content identifier included in the management request, based on the request-area information and the in- group remaining number, if the apparatus that has made the management request is judged to belong to the group, and (ii) manages the duplication of the content identified by the content identifier included in the management request, based on the request-area information and the out- group remaining number, if the apparatus that has made the management request is judged to not belong to the group (**pars. 21-25, domain, household devices, LAN**).

Regarding claim 54, Alve, discloses a content management further comprising: an authentication unit operable to share a session key with the apparatus by conducting authentication processing with the apparatus; and an encryption/decryption unit operable, if authentication is successful, to encrypt and decrypt communication with the apparatus using the session key (**pars. 41-44, encrypted communications**).

Regarding claim 55, Alve, discloses a content management further comprising: a request accumulation unit operable to manage one of a duplication request and a deletion request using a request-arrival sequence queue, and to have said management unit execute a deletion request that is subsequent in the queue to the duplication request, prior to the duplication request, wherein said request receiving unit receives the management request that is at least one of a duplication request and a deletion request (**pars. 43-52, copy control, domain traversal, 56-59, verifying device belongs to domain, 60-65, copy control, domain traversal, positive integer**).

Regarding claim 56, Alve, discloses a content management apparatus of claim 45, further comprising an acquisition unit, wherein the network is a home network connected to an external network, said acquisition unit acquires the content from outside the home network, and said group judging unit judges apparatuses connected to the home network as belonging to the group (**pars. 19-26, home network**).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHINWENDU C. OKORONKWO whose telephone

Art Unit: 2136

number is (571)272-2662. The examiner can normally be reached on MWF 2:30 - 6:00, TR 9:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on (571) 272 4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. C. O./

Examiner, Art Unit 2136

/Brandon S Hoffman/

Primary Examiner, Art Unit 2136